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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

UND007

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on _____

Signature _____

Typed or printed name Stuart T. Langley

Application Number

09/781,920

Filed

February 12, 2001

First Named Inventor

Gregory Hagan Moulton

Art Unit

2134

Examiner

David Y. Jung

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 33,940☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Signature

Stuart T. Langley

Typed or printed name

720-406-5335

Telephone number

9/27/05

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☒*Total of one forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No. 09/781,920	Confirmation No.: 9074
Application of: MOULTON	Customer No.: 25235
Filed: February 12, 2001	
Art Unit: 2134	
Examiner: JUNG, David Yiuk	
Attorney Docket No. UND007	
For: SYSTEM AND METHOD FOR REPRESENTING AND MAINTAINING REDUNDANT DATA SETS UTILIZING DNA TRANSMISSION AND TRANSCRIPTION TECHNIQUES	

ATTACHMENT TO PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the final Office Action mailed May 20, 2005 and the Advisory Action mailed September 8, 2005, Applicants request that the claim rejections be reviewed prior to the filing of an Appeal Brief for the reasons provided in the following paragraphs.

Issues for Review

Applicants believe there are clear errors in the Examiner's rejections that should be reviewed and that such a review will show that the cited references do not support a prima facie obviousness rejection. The issues for review do not involve determining what a reference teaches but instead involves determining

whether what is taught by the reference as construed by the Examiner supports a prima facie rejection of claims based on obviousness.

Premature Final Office Action.

In this case, applicant has not been granted a full and fair hearing, nor have clear issues of patentability been developed. The Final Office action includes a response to arguments section that alleges that "Applicant gave a new definition of 'lexicon'." However, no such new definition has been given. In the response filed February 28, 2005 applicant's argued only the definition of "lexicon" appearing in the four corners of the claims themselves. The advisory action mailed September 8, 2005 does not further explain the position taken in the final office action, nor does the advisory action make even a passing attempt to respond to the request to withdraw finality of the office action.

The Final Office action failed to offer any response or rebuttal to the other points made in the February 28, 2005 response. It is not apparent that these arguments have been considered and given a full and fair hearing. Specifically, the February 28, 2005 response argued that 1) the Gdiff reference does not show a lexicon; 2) the Gdiff reference teaches something opposite the claimed lexicon; 3) the digital sequence contained in the Gdiff file does not correspond to the claimed unique identifier; 4) Gdiff is not a method for *symbolic* exchange. These points were not addressed or rebutted in the final office action and are first addressed in the advisory action mailed September 8, 2005.

Further, the basis for maintaining the rejections stated in final office action was that "Applicant explicitly stated that the amended claims do no change the scope of the claims." However, Applicant never made this explicit statement. Again, the advisory action does not respond to this ground for withdrawing finality.

It is respectfully requested that a non-final office action be issued so that a response can be made to the newly raised arguments. It is believed that a pre-

appeal review is a superior forum for resolving this issue before it reaches the Board of Patent Appeals and Interferences.

Rejections under 35 U.S.C. 103.

Claims 1-46 stand rejected under 35 U.S.C. 103 based upon the Gdiff reference. This rejection was maintained in the September 8, 2005 Advisory Action, and reviewable issues include whether the office action states that 1) the Gdiff reference does not show a lexicon; 2) the Gdiff reference teaches something opposite the claimed lexicon; 3) the digital sequence contained in the Gdiff file does not correspond to the claimed unique identifier; 4) Gdiff is not a method for symbolic exchange. In each of these four issues the advisory action responds not with an answer, but with a question. Moreover, the advisory action appears to agree with Applicant's position in some cases.

The rejection of claim, for example, is based on some unstated definition of the word "lexicon". Although the office action suggests that a broader definition is appropriate, no actual definition is put forth. A "lexicon" as used in claim 1 comprises an association of digital sequences to unique identifiers. Irrespective of the breadth that can be given the term "lexicon", claim 1 itself provides a more specific meaning and context to the term lexicon that cannot be ignored. Specifically, the lexicon in claim 1 has a plurality of digital sequences, and each digital sequence corresponds to a unique identifier. The advisory action responds to this reasoning with questions such as "does the Gdiff reference not show a lexicon?" and "Is this a lexicon?" in combination with general statements of policy underlying patent law. It remains unclear just what part of Gdiff is considered to be a lexicon, and what part of Gdiff is considered to be a unique identifier and what part of Gdiff is considered to be the digital sequence. A pre-appeal review can help clarify these issues before they are presented to the Board.

The Advisory Action poses more questions than it answers. Quite literally. The Advisory action asks "does the Gdiff reference teach something opposite the

claimed lexicon?" The advisory action continues to ask "does the digital sequence contained in the Gdiff not correspond to the claimed unique identifier? Perhaps this is so." Finally, the Advisory Action ponders "is Gdiff not a method for symbolic exchange? What is symbolic?" These questions are substitutes for reasons for rejections under 35 U.S.C. 102 and/or 103. A pre-appeal review can help answer these questions before they are presented to the Board.

Conclusions

In view of all of the above, Applicants respectfully request that a review panel review the Examiner's rejections and produce a finding that there are no actual issues remaining for appeal and that the application is allowed.

A check is enclosed for the fee associated with a filing of a Notice of Appeal. Additionally, any fee deficiency associated with this submittal may be charged to Deposit Account No. 50-1123.

Respectfully submitted,

September 27, 2005



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